

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 3 and 23 are requested to be cancelled without prejudice. Applicants reserve the right to present the subject matter of the canceled claims in later applications or proceedings.

Claims 1-2, 16, and 28 are requested to be amended.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate status identifier for each.

After amending the claims as set forth above, claims 1-2, 4-22, 24-25, and 28 are now pending in this application.

Drawings

In section 1 of the Office Action, the drawings are objected to under 37 C.F.R. § 1.83(a) as not showing “the visual display unit being usable in a compact state when attached to the processing unit.” Applicants respectfully submit that Figure 1 of the drawings shows folding lines 138a through 138c, which are configured to allow the visual display to be folded into the usable compact state. Figure 8 also indicates that data may be viewed using a visual display unit in a compact state. Accordingly, Applicants believe that the drawings are in compliance with 37 C.F.R. § 1.83(a) and request withdrawal of the objection to the drawings.

Claim Rejections – 35 U.S.C. § 103(a)

- a. Rejection of claims 1-6, 13, and 28 based on Lebby et al. in view of Failla and further in view of Takafumi et al.**

In section 2 of the Office Action, the Examiner rejected claims 1-6, 13, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Lebby et al. (U.S. Patent No. 6,115,618) in view of

Failla (U.S. Patent No. 5,128,662) and further in view of Takafumi et al. (Japanese Published Patent Application No. JP 10-020962).

i. Claims 1-6 and 13

With regard to claim 1, Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness. More specifically, for at least the reasons stated below, no proper combination of Lebby et al., Failla, and Takafumi et al. teaches or suggests the subject matter of claim 1 as amended.

To establish a prima facie case of obviousness based on a combination of a prior art reference under 35 U.S.C. § 103(a) and knowledge of one of ordinary skill in the art, the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. See Manual of Patent Examining Procedure § 2143.01. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references. In re Fritsch, 972 F.2d 1260 (Fed. Cir. 1992). In this case, the Examiner has not shown that there would have been any motivation or suggestion to one of skill in the art to combine Lebby et al., Failla, and Takafumi et al. to arrive at the subject matter of claim 1 as amended.

The final Office Action acknowledges that “Lebby as modified by Failla did not explicitly teach that the display unit being usable in a compact state when attached to the processor.” However, the final Office Action further states that “Takafumi et al is cited to teach that it is well known for a display unit to be in a compact state when attached to the processing unit (see, figs. 2 and 6). The final Office Action concludes that:

Therefore, it would have been obvious to one skill in the art at the time of the invention was made to incorporate the method reducing the display unit as taught by Takafumi et al into the display system of Lebby because this will provide the information processor where

a portable main body is miniaturized to be operated as a desktop type of display to accommodate the user with more flexible future.

Applicants respectfully disagree.

While the Office Action states that “this will provide the information processor where a portable main body is miniaturized to be operated as a desktop type of display to accommodate the user with more flexible future,” it is unclear as to how this provides a motivation to combine the teachings of Takafumi et al. with the proposed combination of the device of Lebby et al. and the folding display of Failla. Rather, the statement in the final Office Action merely speculates that an advantage of Takafumi et al. may also be obtained if Lebby et al. is somehow modified to include teachings of Takafumi et al. The final Office Action does not provide any indication as to how the teachings of Lebby et al. or Failla would have to be modified to include the teachings of Takafumi et al. in order to achieve such advantage, or how the teachings of Takafumi et al. would work with the teachings of Lebby et al. or Failla. Further, there is no teaching or suggestion in either Lebby et al. and Failla that their teachings are compatible.

As such, the statements in the Office Action regarding the motivation to combine Lebby et al., Failla, or Takafumi et al. do not evince the “thorough and searching inquiry” required by the U.S. Court of Appeals for the Federal Circuit. See McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). Moreover, the alleged motivation cited in the Office Action is similar to reasoning which was held to be insufficient to support a motivation to combine teachings of cited references by the U.S. Court of Appeals for the Federal Circuit. In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002).

In fact, a significant inconsistency exists between the teachings of Takafumi et al. the combination of Lebby et al. and Failla suggested by the Office Action such that one of ordinary skill in the art would not be motivated to further combine the teachings of Takafumi et al. with the combination of Lebby et al. and Failla. The Office Action acknowledges that “Lebby as modified by Failla did not explicitly teach that the display unit being usable in a compact state when attached to the processor.” That is, the Office Action presumably implies that the display

screen as taught by Failla and combined with the separable display of Lebby et al. is only usable in an unfolded state and is thus not usable in a compact state even if attached to the controller 52 of Lebby et al. To overcome this deficiency, the Office Action asserts that Figs. 2 and 6 of Takafumi et al. show that “it is well known for a display unit to be in a compact state when attached to the processing unit.” The Office Action thus implies that the teachings of Takafumi et al. may be applied to any display when attached to a processing unit to render such display usable in the compact state. Applicants respectfully submit that Takafumi et al., when viewed as a whole, does not disclose such an abstract concept, and that the alleged compact state cited by the Office Action as being taught by Takafumi et al. in Figs. 2 and 6 is inconsistent with the folded display combination of Lebby et al. and Failla.

When viewed as a whole, Takafumi et al. teaches only that, by virtue of having processor 32 and display units 11 and 21 combined in a single main body 100, when main body 100 is attached to the holding device 5, display units 11 and 21 may provide a larger display (shown in Fig. 1 of Takafumi et al.) as part of a desk computer. When main body 100 is not attached to the holding device 5, main body 100 functions as a separate pocket computer (shown in Fig. 2 of Takafumi et al. and cited as being a compact state in the Office Action). However, display units 11 and 21 of the pocket computer formed by the main body 100 of Takafumi et al. are only usable when unfolded to expose them. As such, the teachings of Takafumi et al. would not address the above-noted deficiency in the combination of Lebby et al. and Failla. Thus, Applicants respectfully submit that one of ordinary skill in the art would not be motivated to combine the teachings of Takafumi et al. with the combination of Lebby et al. and Failla suggested by the Office Action. Modifying the display screen as taught by Failla and combined with the separable display of Lebby et al. by simply attaching another processor to form a unit separate from the portable electronic device 10 of Lebby et al. would still not render the display screen as taught by Failla usable when folded and attached to controller 52.

Because there is no motivation or suggestion to one of skill in the art to combine Lebby et al., Failla, and Takafumi et al. to arrive at the subject matter of claim 1 as amended, the Office

Action fails to establish a proper case of obviousness. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 2, 4-6, and 13 depend from claim 1 and are thus patentable for at least the same reasons as claim 1, and Applicants request that the rejection of claims 2, 4-6, and 13 under 35 U.S.C. § 103(a) be withdrawn as well.

ii. Claim 28

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 28. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). Applicants respectfully submit that the cited combination of Lebby et al., Failla, and Takafumi et al. fails to teach or suggest “displaying information on a visual display unit in a compact state wherein layers of the display are folded over each other when coupled to a handheld computer” as recited in the combination of steps of claim 28 as amended.

The final Office Action acknowledges that “Lebby as modified by Failla did not explicitly teach that the display unit being usable in a compact state when attached to the processor.” However, the final Office Action further states that “Takafumi et al is cited to teach that it is well known for a display unit to be in a compact state when attached to the processing unit (see, figs. 2 and 6). However, display units 11 and 21 of the pocket computer formed by the main body 100 of Takafumi et al. are only usable when unfolded to expose them. Thus the cited combination of Lebby et al., Failla, and Takafumi et al. fails to teach or suggest “displaying information on a visual display unit in a compact state wherein layers of the display are folded over each other when coupled to a handheld computer” as recited in the combination of steps of claim 28 as amended. Accordingly, Applicants respectfully request that the rejection of claim 28 under 35 U.S.C. § 103(a) be withdrawn.

b. Rejection of claims 1, 7, 10-12, 16-20, and 22-25 based on Oliwa et al. in view of Lebby et al. and Failla and further in view of Takafumi et al.

In section 11 of the Office Action, the Examiner rejected claims 1, 7, 10-12, 16-20, and 22-25 under 35 U.S.C. § 103(a) as being unpatentable over Oliwa et al. (U.S. Patent No. 4,856,088) in view of Lebby et al. and Failla, and further in view of Takafumi et al.

i. Claims 1, 7, and 10-12

With regard to claim 1, Applicants respectfully submit that, for at least the same reasons set forth above with regard to claim 1, there is no motivation or suggestion to one of skill in the art to combine Oliwa et al., Lebby et al., Failla, and Takafumi et al. to arrive at the subject matter of claim 1 as amended, the Office Action fails to establish a proper case of obviousness. Accordingly, Applicants respectfully request that the rejection of claim 1 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 7 and 10-12 depend from claim 1 and are thus patentable for at least the same reasons as claim 1, and Applicants request that the rejection of claims 7 and 10-12 under 35 U.S.C. § 103(a) be withdrawn as well.

ii. Claims 16-20 and 22-25

Applicants respectfully submit that the Office Action fails to establish a prima facie case of obviousness with respect to claim 16. To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). Applicants respectfully submit that the cited combination of Lebby et al., Failla, and Takafumi et al. fails to teach or suggest “wherein the visual display unit can be expanded from a compact state wherein layers of the display are folded over each other, and the visual display unit is useable in the compact state when attached to the handheld computer device” as recited in the combination of elements of claim 16 as amended.

The final Office Action acknowledges that “Oliwa as modified by Lebby and Failla did not explicitly teach that the display unit being usable in a compact state when attached to the processor.” However, the final Office Action further states that “Takafumi et al is cited to teach

that it is well known for a display unit to be in a compact state when attached to the processing unit (see, figs. 2 and 6). However, display units 11 and 21 of the pocket computer formed by the main body 100 of Takafumi et al. are only usable when unfolded to expose them. Thus the cited combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al. fails to teach or suggest “wherein the visual display unit can be expanded from a compact state wherein layers of the display are folded over each other, and the visual display unit is useable in the compact state when attached to the handheld computer device” as recited in the combination of elements of claim 28 as amended. Accordingly, Applicants respectfully request that the rejection of claim 28 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 17-20, 22, and 24-25 depend from claim 16 and are thus patentable for at least the same reasons as claim 16, and Applicants request that the rejection of claims 17-20, 22, and 24-25 under 35 U.S.C. § 103(a) be withdrawn as well.

c. Rejection of claims 8, 9, and 21 based on Oliwa et al. in view of Lebby et al. and Failla and further in view of Takafumi et al. and further in view of “A Comparison of Display Technologies for E-Books” by Dr. J. William Doane

In section 24 of the Office Action, the Examiner rejected claims 8, 9, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Oliwa et al. in view of Lebby et al. and Failla, and further in view of Takafumi et al. and further in view of “A Comparison of Display Technologies for E-Books” by Dr. J. William Doane.”

i. Claims 8-9

Claims 8-9 depend from claim 1. As stated above with regard to claim 1, there is no motivation for making the combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al. As to A Comparison of Display Technologies for E-Books” by Dr. J. William Doane, it does not appear to make up for all of the above-mentioned deficiencies. Because no proper combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al. and A Comparison of Display Technologies for E-Books” by Dr. J. William Doane discloses the subject matter of claim 1, and because claims 8-9 depend from claim 1, Applicants respectfully submit that claims 8-9 are patentable over the cited combination of references for at least the same reasons as claim 1.

Accordingly, Applicants respectfully request that the rejection of claims 8-9 under 35 U.S.C. §103(a) be withdrawn.

ii. Claim 21

Claim 21 depends from claim 16. As stated above with regard to claim 16, the combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al. does not disclose or teach all of the claim limitations recited in claim 16. As to A Comparison of Display Technologies for E-Books” by Dr. J. William Doane, it does not appear to make up for all of the above-mentioned deficiencies. Because no proper combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al. and A Comparison of Display Technologies for E-Books” by Dr. J. William Doane discloses the subject matter of claim 16, and because claim 21 depends from claim 16, Applicants respectfully submit that claim 21 is patentable over the cited combination of references for at least the same reasons as claim 16. Accordingly, Applicants respectfully request that the rejection of claim 21 under 35 U.S.C. §103(a) be withdrawn.

d. Rejection of claims 14 and 15 based on Oliwa et al. in view of Lebby et al. and Failla and further in view of Takafumi et al. and further in view of Morrison et al.

In section 27 of the Office Action, the Examiner rejected claims 14 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Oliwa et al. in view of Lebby et al. and Failla, and further in view of Takafumi et al. and further in view of Morrison et al.

Claims 14-15 depend from claim 1. As stated above with regard to claim 1, there is no motivation for making the combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al.. As to Morrison et al., it does not appear to make up for all of the above-mentioned deficiencies. Because no proper combination of Oliwa et al., Lebby et al., Failla, and Takafumi et al. and Morrison et al. discloses the subject matter of claim 1, and because claims 14-15 depend from claim 1, Applicants respectfully submit that claims 14-15 are patentable over the cited

combination of references for at least the same reasons as claim 1. Accordingly, Applicants respectfully request that the rejection of claims 14-15 under 35 U.S.C. §103(a) be withdrawn.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 1/10/2006

By Chad E. Bement

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5554
Facsimile: (414) 297-4900

Chad E. Bement
Attorney for Applicant
Registration No. 54,991